

Appl. No. 10/826,979
Atty. Docket No. 2003B050A
Response dated May 16, 2007
Reply to Office Action dated January 16, 2007

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REMARKS

Reconsideration of the present application in view of the following remarks is respectfully requested. This Response replies to the Office Action mailed January 16, 2007.

Contrary to the Examiner's Office Action Summary, claims 2-14, 28-33, 40-42, 44-56, 70-75, 82-88, 171-184 and 198-203 are pending in the application. Claims 76-81 were previously cancelled. Claims 28-33, 70-75, and 198-203 are cancelled without prejudice to or disclaimer of the subject matter contained therein. Applicant has cancelled those claims to reduce issues for appeal and/or to place the application in condition for allowance, preserving the right to pursue the cancelled subject matter in one or more continuation or divisional applications. Applicant has not amended any claims. Therefore, claims 2-14, 40-42, 44-56, 82-88, and 171-184 are now pending in the application.

Obviousness-Type Double Patenting

Claims 2-14, 28-33, 40-42, 44-56, 70-88, 171-184 and 198-203 stand provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1-25 and 47-60 of Domine et al. (U.S. Publication No. 2004/0076846A1), and claims 2-14, 28-33, 40-42, 44-56, 70-88, 171-184 and 198-203 stand provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1-42 and 64-81 of Domine et al. (U.S. Publication No. 2004/0161623A1).

Applicants reiterate their previous objections and traversal of these provisional double patenting rejections. The rejections are provisional because no subject matter has been deemed allowable. Since there are no claims allowed, there is no patent term to disclaim. Until such point as any pending claim is allowable but for such double patenting rejections, a terminal disclaimer is premature. *See* M.P.E.P. 804(I)(B). Abeyance of the rejection is respectfully requested.

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35 U.S.C. §102(b) - Anticipation

Claims 4, 28-33, 56, 70-88, 175, 182-184, and 198-203 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Domine et al. (International Publication No. WO 02/078953; hereafter "Domine").

Applicant submits the Examiner has mis-referenced the claims and respectfully requests clarification for the record. Particularly, the Examiner states at page 5 that Domine does not teach an epoxy containing-compound (twice) or an amine containing compound; yet, claims 4, 56, 76-88, 175, and 182-184 directed to an epoxy containing-compound or an amine containing compound stand anticipated by Domine. Withdrawal of the rejection or clarification is respectfully requested.

Furthermore, Domine is not prior art under 35 U.S.C. § 102(b). The present invention claims priority to US Provisional No. 60/473,783 which was filed on May 27, 2003. Domine was published on October 10, 2002 which is not more than one year prior to the earliest effective filing date of the present invention. Withdrawal of the rejection or clarification is respectfully requested.

Notwithstanding, Domine does not teach, show or suggest a tie-layer comprising a (co)extrudable tie resin (CTR), wherein the CTR comprises one or more amine-containing monomers as required in base claims 2 and 44 and those dependent therefrom, including rejected claims 4 and 82-88. Domine also does not teach, show or suggest a CTR comprising an epoxy-containing polymer as required in base claims 14, 56, 175, 182, and 184 and those dependent therefrom. Accordingly, withdrawal of the rejection and allowance of the claims is respectfully requested.

35 U.S.C. §103(a) - Obviousness

Claims 2-3, 5-14, 40-42, 44-55, 171-174, and 176-181 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Domine as applied to claims 2 and 44 above, and further in view of Iovine et al. (U.S. Patent No. 4,948,822; hereafter "Iovine").

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The pending Office Action mis-states that the Domine reference was a basis for rejection of claims 2 & 44. But, Domine was not applied to claims 2 and 44 anywhere in the Office Action. Withdrawal or clarification of the rejection is respectfully requested.

Notwithstanding, Applicant respectfully traverses the rejection on grounds that the Examiner has not established a *prima facie* case of obviousness. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *see also* M.P.E.P. § 2143.01.

Here, the proposed modification to Domine would render its laminates unsuitable for their intended purpose, which is to be extruded. The polymers/resins of Iovine are not extrudable. Iovine discloses laminating adhesives that incorporate acrylic polymer emulsions. Emulsions cannot be extruded. *See* Iovine at Abstract; col. 2, ll. 22-31; and col. 3, ll. 37-48. As such, the emulsions of Iovine are not extrudable and cannot be extruded with the polymers of Domine. Therefore, the Examiner's proposed modification of Domine renders Domine unsatisfactory for its intended purpose, and cannot establish a *prima facie* case of obviousness. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 5-13, 28-33, 47-56, 175-183 and 198-203 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Domine in view of Kojima et al. (U.S. Patent No. 4,654,255; hereafter "Kojima").

A combination of Domine and Kojima does not arrive at the claimed invention and/or would render Domine's laminates unsuitable for their intended purpose which is to be extruded. Therefore, there is no suggestion or motivation to make the proposed modification.

Pending claims 5-13, 47-56, and 175-183 each require a coextrudable tie resin that comprises an epoxy-containing polymer. Like Iovine, the copolymers/resins described in Kojima

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Kojima at col. 8, ll. 37-40. Additionally, the copolymers of Kojima are unlikely to flow at extrusion temperatures (100°C-300°C) because the copolymers of Kojima are graft reacted at those temperatures (100°C-300°C). Moreover, the copolymers of Kojima are reported to have high bond strengths, as reported in Table 1 of the examples. *Id.* at col. 4, lines 50-58, and at the examples. Resins with such high bond strengths are very difficult if not impossible to coextrude.

Withdrawal of the rejection and allowance of the claims is respectfully requested.

CONCLUSION

Applicants believe that the foregoing is a full and complete response to the Office Action of record. For the foregoing reasons, Applicants submit that the present claims meet all the requirements for patentability. Accordingly, an early and favorable reconsideration of the rejection, and allowance of pending claims 2-14, 40-42, 44-56, 82-88, and 171-184 are requested.

The Commissioner is hereby authorized to charge counsel's Deposit Account No. 05-1712, for any fees, including extension of time fees and excess claim fees, required to make this response timely and acceptable to the Office.

Respectfully submitted,



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